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DOCKET NO. TOS-164-USA-PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE THE APPLICATION OF: K. Kinoshita, et al.

SERIAL NO.: 10/517,147

GROUP: 1751

FILED: December 7, 2004

EXAMINER: N. Ogden

TITLE: Detergent Compositions

Mail Stop Appeal Brief-Patents
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA. 22313-1450

SIR:

TRANSMITTED HEREWITH IS AN ☐ RESPONSE TO FINAL OFFICE ACTION, ☐ REPLY, ☒ APPEAL BRIEF IN THE ABOVE-IDENTIFIED APPLICATION.

- ☐ Small entity status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a verified statement previously submitted.
- ☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
- ☒ No additional fee is required.

THE FEE HAS BEEN CALCULATED AS SHOWN BELOW:

CLAIMS	REMAINING AFTER AMENDMENT		HIGH.# PREV. PAID FOR	PRESENT EXTRA	SMALL ENTITY RATE ADD'L FEE	OTHER THAN A SMALL ENTITY RATE ADD'L FEE
TOTAL	21	MINUS	21	- 0	X25-\$	X50-\$0
INDEP.	2	MINUS	3	- 0	X100-\$	X200-\$0

<input type="checkbox"/> FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM		+180-\$	+360-\$
	TOTAL ADD'L FEE		-0-

- ☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 20-1424. A duplicate copy of this sheet is attached.

- ☒ Any additional filing fees under 37 C.F.R. 1.16 for the presentation of extra claims.
- ☒ Any patent application processing fees under 37 C.F.R. 1.17.
- ☒ Any extensions of time under 37 C.F.R. 1.17.

☒ Please charge my deposit account No. 20-1424 in the amount of \$ 500, as required by 41.20(b)(2) for the filing of the attached Appeal Brief.

☐ A check in the amount \$ -0- is attached.



DOCKET NO. TOS-164-USA-PCT

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Date: February 19, 2006

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CERTIFICATE OF MAILING

I hereby certify that this Transmittal of Appeal Brief, as well as the attached Appellant's Brief on Appeal, in Docket No. TOS-164-USA-PCT, Serial No. 10/517,147, filed December 7, 2004, is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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on February 19, 2007.

Donald E. Townsend



TOS-164-USA-PCT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Koichi Kinoshita, et al.

Serial No.: **10/517,147**

Filed: **December 07, 2004**

For: **Detergent Compositions**

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Examiner: **N. Ogden**

Group Art Unit: **1751**

Docket: **TOS-159-USA-PCT**

APPELLANT'S BRIEF ON APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir: The undersigned respectfully appeals to the Patent Board of Appeal and Interferences the final rejection of the above-identified application, as stated in the Final Office Action mailed herein on June 28, 2006, and the Advisory Action mailed herein on September 12, 2006, as follows:

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee,
Shiseido Co., Ltd.

2. RELATED APPEALS AND INTERFERENCES

None.

3. STATUS OF THE CLAIMS

1. Rejected
2. Rejected
3. Rejected
4. Rejected
5. Rejected
6. Rejected
7. Cancelled
8. Rejected
9. Cancelled
10. Rejected
11. Rejected
12. Cancelled
13. Rejected
14. Rejected
15. Cancelled
16. Cancelled
17. Cancelled
18. Cancelled
19. Rejected
20. Rejected
21. Rejected
22. Rejected
23. Rejected
24. Rejected
25. Rejected
26. Rejected
27. Rejected
28. Rejected

4. STATUS OF AMENDMENTS

A Response After Final was filed August 24, 2006. This Response has been entered and considered by the Examiner. No amendment has been filed subsequent to final rejection herein.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention provides a cleaning agent composition which is in a paste or solid form over a wide temperature range, foams adequately, gives good sensation during use without causing a tingling sensation of the skin, exhibits superior stability, doesn't cause sliminess during rinsing, and exhibits a creamy foam quality (Specification, page 5, lines 1-8, and page 6, lines 1-9).

More particularly, the present invention, as now claimed in base claim 1 herein, provides a paste or solid cleaning agent (Specification, page 5, lines 10-11), comprising (a) 5-50 mass% of an acyl salt anionic surfactant represented by the following general formula (1) ($R^1CO-NR^2CH_2CH_2SO_3X$) (Specification, page 5, lines 12-13, and page 9, lines 5-6), (b) one or more chosen from inorganic salts, organic acids, and organic salts (see Specification, page 5, lines 14-15), (c) polyethylene glycol (Specification, page 5, line 16), (d) water (Specification, page 5, line 16) wherein the electrolyte molar concentration is 1.8 mol/kg or more (Specification, page 5, lines 11-12), and (e) one or more chosen from taurine, N-methyltaurine, and N,N-dimethyltaurine (Specification, page 13, lines 7-11).

If the blend ratio of the acyl salt anionic surfactant is too small, then foaming becomes poor; if the blend ratio is too large, then there are shortcomings such as reduced productivity and difficulty in taking the product out of the container due to hardness (Specification, page 9, lines 5-10). Importantly, it is preferable to add one or more of taurine, N-methyltaurine and N,N-dimethyltaurine, as these components further reduce the tingling sensation on the skin during use, as well as contributing to achieving the desirable paste form (Specification, page 13, lines 7-11).

In addition to base independent claim 1, the present application includes base independent claim 8. Base claim 8 provides a paste or solid cleaning agent composition having a system melting point of 40° or higher (Specification, page 6, lines 10-11), that assumes a paste or solid form in a wide temperature range, foams adequately, gives a good sensation during use without causing sliminess during rinsing, and exhibits superior stability (Specification, page 6, lines 2-5). Further, the cleaning agent composition of claim 8 produces no tingling sensation during use and exhibits a creamy foam quality (Specification, page 6, lines 7-8).

The paste or solid cleaning agent of claim 8 comprises (a) one or more long chain acyl taurine salts, having a Kraft point of 40° or lower, represented by the general formula (I) $(R_1 \text{ CO-NR}_2 \text{ -CH}_2 \text{ CH}_2 \text{ SO}_3 \text{ M})$, wherein R_1 denotes a saturated or unsaturated hydrocarbon group with an average number of carbon atoms of 7-19; R_2 denotes an alkyl group with an average number of carbon atoms of 1-3; and M denotes an alkali metal, alkali earth metal, ammonium, or organic amine or derivative) (Specification, page 6, lines 12-13, and line 12, to page 7, line 2), (b) one or more chosen from inorganic salts and organic salts (page 6, lines 13-14), (c) trihydric or higher polyol (Specification, page 6, lines 14-15), (d) water (Specification, page 6, line 15), and (e) one or more chosen from taurines and nonionic surfactants having a HLB of 10 or more (Specification, page 7, lines 15-19).

6. ISSUES PRESENTED FOR REVIEW

I. Whether Claims 1-6, 8, 10-11, 13-14 and 19-28 are unpatentable under 35 U.S.C. 103(a) as being obvious over JP 58-101197 in view of JP 2001-1233743.

II. Whether the Examiner can retroactively apply a rejection, via a statement in an Advisory Action, that was NOT specifically and clearly predicated in the final Office Action.

III. If the Board rules in the affirmative on Issue II above, whether claims 1-6, 8, 10-11, 13-14 and 19-28 are unpatentable under 35 U.S.C. 103(a) over JP 1-178596 in view of JP 2001-1233743.

7. ARGUMENTS

I. Rejection Under 35 U.S.C. 103(a) over JP 58-101197 in view of JP 2001-233743

(a) Claims 1-6 and 20-24:

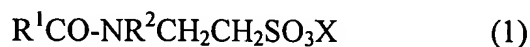
The cited JP 58-101197 reference discloses a creamy detergent composition comprising, as surfactants, a phosphate surfactant and a taurate surfactant. In particular, a creamy detergent is disclosed comprising sodium methyl myristoyl taurate, sodium chloride, polyethylene glycol, glycerin, and water (see International Search Report of corresponding International application No. PCT/JP03/01298).

The Examiner specifically cited the following cream detergent composition in Example 6 of the '197, which includes the following ingredients:

30 mass% sodium monolaurylphosphate
10 mass% sodium monomyristylphosphate
6 mass% sodium N-myristoyl methyl taurine
7 mass% sodium chloride
7 mass% polyethylene glycol
10 mass% glycerol
0.3 mass% perfumes
residual water

In the above cream detergent composition specifically cited by the Examiner, the sodium

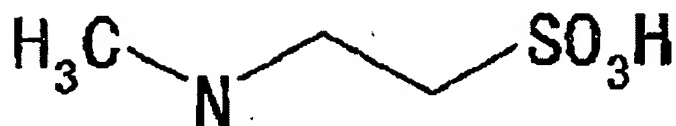
monolaurylphosphate and the monomyristylphosphate serve as the main surfactants and together constitute 40 mass% of the composition. In contrast, the present invention, as claimed in claim 1, utilizes, as the main surfactant, 5-50 mass % of an acyl salt anionic surfactant represented by the following general formula (1):



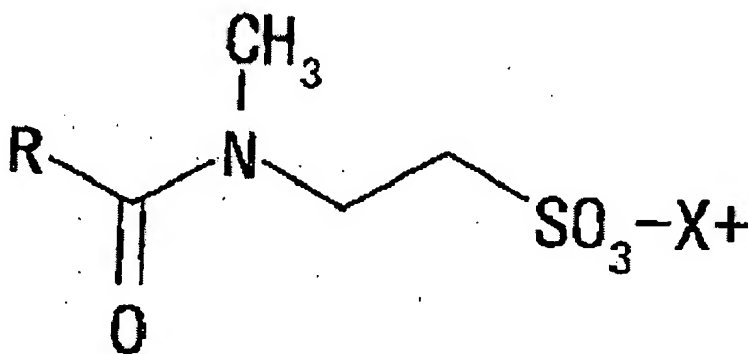
(In this formula, R^1 denotes a hydrocarbon group having 10-24 carbons, R^2 denotes a hydrogen atom or methyl group, and X denotes an alkali metal, alkali earth metal, ammonium, or organic amine). Such an acyl salt anionic surfactant is disclosed only as a secondary, non-essential surfactant in the '596 reference, and is always present in a larger amount than secondary surfactants, such as the metal soaps disclosed in the '596 reference.

Further, the '197 reference fails to disclose the inclusion one or more of taurine, N-methyltaurine, and N,N-dimethyltaurine, in combination with elements (a)-(d), as called for in appealed base claim 1. The '743 reference, the Examiner's secondary reference, fails to cure the deficiencies of the Examiner's primary reference. In particular, the '743 reference discloses a hair detergent comprising 1 - 30 wt% of an *acyl N-methyltaurine salt* and 70 - 99 wt% of polyhydric alcohols. It is respectfully submitted that there is no disclosure whatever in the '743 reference of the use of one or more of taurines, N-methyltaurine and N, N-dimethyltaurine in combination with the ingredients (a) - (d) as called for in Claim 1. On the contrary, that teaching or suggestion comes only from the present application and constitutes an important element or aspect of the present invention.

Importantly, the present invention claims N-methyltaurine, having the structure shown below:



In contrast, the closest composition to the claimed N-methyltaurine that the '743 reference discloses is an acyl N-methyltaurine salt. Acyl N-methyltaurine has the structure shown below:



It is respectfully submitted that acyl N-methyltaurine, as taught by the '743 reference and as shown above, is neither equivalent to, nor provides the same effects as, the N-methyltaurine claimed herein. Moreover, it is respectfully urged that the misinterpretation of the '743 reference is not harmless error since the lack of taurine, N-methyltaurine, and N,N-dimethyltaurine in the '743 reference was intended to cure the deficiencies of the '197 reference. Consequently, the basis upon which the rejection is predicated is in error since neither of the Examiner's

combination of references teaches or suggests the use in a detergent composition of one or more of taurine, N-methyltaurine, and N,N-dimethyltaurine, as required by claims 1-6 and 20-24.

Another issue presented is whether the prior art relied upon by the Examiner suggests the desirability of the claimed invention.

It is respectfully submitted that the answer to this issue is unequivocally in the negative for the reasons discussed hereinafter.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce a claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one skilled in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 55 USPQ 2d 1313, 1317 (Fed.Cir. 2000).

In the present case, the problem to be solved is to produce a detergent composition which is in a paste or solid form over a wide temperature range, foams adequately, gives good sensation during use without causing a tingling sensation of the skin, exhibits superior stability, doesn't cause sliminess during rinsing, and exhibits a creamy foam quality (Specification, page 5, lines 1-8, and page 6, lines 1-9).

The '743 reference fails to disclose that the use of taurine, N-methyltaurine and N,N-dimethyltaurine, or taurines, would solve the problems of the present invention. For this reason, it is clear that the prior art relied upon by the Examiner fails to suggest the desirability of the claimed invention. Consequently, it is respectfully submitted that the rejection fails as a matter of

law in view of the above authority.

Moreover, the '197 and '743 references fail to teach the unexpected results obtained by providing a paste or solid cleaning agent comprised of ingredients (a)-(e), as called for herein in base claim 1. In particular, the present inventors prepared numerous test compositions, and conducted numerous tests to determine the Kraft point of the test compositions, the external stability of the test composition after one week at 45°, the tingling sensation experienced by a user during use of the test compositions, foaming characteristics of the test compositions, smoothness at time of rinsing of the composition, moist sensation of the skin after drying, smoothness of the skin after drying, pH of the test composition, foam quality of the composition, refreshing sensation at the time of rinsing, and temperature dependence of the hardness.

As depicted in Table 2, for Experimental Examples 1-12, when polyethylene glycol was used in the claimed combination in an amount of 20 mass%, as called for in claim 22, the cleaning agent composition had a high Kraft point, good external appearance stability after 1 week at 45°, and a reduced tingling sensation during use. Likewise, Examples 13-27, prepared according to the present invention, exhibited similar characteristics.

With regards to the amount and quality of foam produced by the cleaning agent of the present invention, Experimental Examples 28-33 were prepared, as described on pages 24-25, and as shown in Table 4a on page 34 of the instant application. As depicted therein, it was unexpectedly discovered that satisfactory amounts and quality of foam are produced by the cleaning agent of the present invention within a pH range of 4.8-5.9.

Additionally, as shown in Table 5a, and as discussed on page 36, first paragraph,

Examples 1 and 2, containing the claimed ingredient (a) of claim 1 within the claimed mass% range, exhibited superior temperature dependence of the hardness, external appearance stability after 1 week at 45°, usability of the foam, smoothness at the time of rinsing, moist sensation after drying, and smoothness after drying, in comparison to Comparative Examples 1-4.

Regarding the composition of base claim 8, tests were conducted to determine the stability, foaming and usability of same, the results of the test being shown in Table 1b on page 44, and as shown in Table 2b on page 45. As discussed on page 44, lines 2-14, it was unexpectedly discovered that, by combining two anionic surfactants (sodium lauroyl methyltaurate and sodium myristoyl methyltaurate) as ingredient (a) with sodium chloride as ingredient (b), glycerin as ingredient (c), and water as ingredient (d), a composition is produced which exhibited superior stability, good foaming and a refreshing sensation during use.

In contrast, Comparative Examples 1-4, failed to simultaneously exhibit good stability, good foaming and a refreshing sensation during use. Comparative Example 4, which contained solely an anionic surfactant (sodium myristoyl glutamate), had good stability and a refreshing sensation, but exhibited poor foaming ability.

Importantly, as illustrated in Tables 3b and 4b on pages 52 and 53 of the instant application, it was unexpectedly discovered that, in contrast to Comparative Examples 1-V which only contained claimed ingredients (a)-(d), compositions additionally containing taurine as ingredient (e), in combination with claimed elements (a)-(d) (see Examples I-III therein) exhibited superior stability, foaming, and usability (refreshing sensation), AS WELL AS little tingling sensation during use, high foaming quality (creaminess), and excellent external appearance stability after 1 week at 45°.

Proof of an unexpected improvement can rebut a *prima facie* case of obviousness. *In re Murch* 464 F2d 1051, 175 USPQ 89 (CCPA 1972); *In re Costello* 480 F2d 894, 178 USPQ 290 (CCPA 1973).

As discussed above, the present inventors unexpectedly discovered that superior stability, reduced tingling sensation experienced by a user during use, superior foaming, superior smoothness at time of rinsing, superior moist sensation of the skin after drying, superior smoothness of the skin after drying, superior foam quality of the composition, an improved refreshing sensation at the time of rinsing, and superior temperature dependence of the hardness of the composition of the present invention can be obtained when combining claimed elements (a)-(e) of base claims 1 and 8 in the manner called for in the claims herein. It is therefore believed that these test results evidencing unexpected results rebut any *prima facie* case of obviousness.

In view of the deficiencies of the '197 and '743 references, and the unexpected improvements of the composition as claimed herein, it is believed that the final rejection is unwarranted, and that the Board should overrule the Examiner.

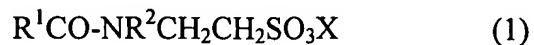
(b) Claim 8, 10-11, 13, 14, 19 and 25-28:

The cited JP 58-101197 reference (hereinafter "'197 reference") discloses a creamy detergent composition comprising, as surfactants, a phosphate surfactant and a taurate surfactant. In particular, the '197 reference discloses a creamy detergent comprising sodium methyl myristoyl taurate, sodium chloride, polyethylene glycol, glycerin, and water (see International Search Report of corresponding International application No. PCT/JP03/01298).

In the final Office Action mailed June 28, 2006, the Examiner specifically cited the following cream detergent composition in Example 6 of the '197 reference, which includes the following ingredients:

30 mass% sodium monolaurylphosphate
10 mass% sodium monomyristylphosphate
6 mass% sodium N-myristoyl methyl taurine
7 mass% sodium chloride
7 mass% polyethylene glycol
10 mass% glycerol
0.3 mass% perfumes
residual water

In the above cream detergent composition relied upon by the Examiner, the sodium monolaurylphosphate and the monomyristylphosphate serve as the main surfactants, and together constitute 40 mass% of the composition. In contrast, the present invention, as called for in claim 8, utilizes, as the main anionic surfactant, long chain acyl taurine salts, having a Kraft point of 40° or lower, represented by the following general formula (1):



(In this formula, R_1 denotes a saturated or unsaturated hydrocarbon group with an average

number of carbon atoms of 7-19; R₂ denotes an alkyl group with an average number of carbon atoms of 1-3; and M denotes an alkali metal, alkali earth metal, ammonium, or organic amine or derivative). Such an acyl salt anionic surfactant is disclosed only as a secondary, non-essential surfactant in the '596 reference, and is always present in a larger amount than secondary surfactants, such as the metal soaps disclosed in the '596 reference.

Importantly, the '197 reference fails to disclose the inclusion of taurines and nonionic surfactants having a HLB of 10 or more in combination with elements (a)-(d), as required by independent base claim 8. The '743 reference, the Examiner's secondary reference, fails to cure the deficiencies of the Examiner's primary reference, i.e., does NOT disclose the inclusion of taurines and nonionic surfactants having a HLB of 10 or more in combination with elements (a)-(d).

In particular, the '743 reference discloses a hair detergent comprising 1 - 30 wt% of an acyl N-methyltaurine salt and 70 - 99 wt% of polyhydric alcohols. It is respectfully submitted that there is no disclosure whatever in the '743 reference of the use of one or more taurines and nonanionic surfactants having a HLB of 10 or more together with the components (a) - (d) as called for in claims 8, 10-11, 13, 14, 19 and 25-28 herein. On the contrary, that teaching or suggestion comes only from the present application and constitutes an important element or aspect of the present invention.

Moreover, it is respectfully urged that the misinterpretation of the '743 reference is NOT harmless error, since the disclosure of taurines and nonionic surfactants having a HLB of 10 or more, in combination with elements (a)-(d), in the '743 reference was intended to cure the deficiencies of the '197 reference. Consequently, the basis upon which the rejection is predicated

is in error, since neither of the Examiner's combination of references teaches or suggests the use in a detergent composition of taurines or non-anionic surfactants having an HLB of 10 or more with the other ingredients required by the claim 8.

Another issue presented is whether the prior art relied upon by the Examiner suggests the desirability of the claimed invention.

It is respectfully submitted that the answer to this issue is unequivocally in the negative for the reasons discussed hereinafter.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce a claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one skilled in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 55 USPQ 2d 1313, 1317 (Fed.Cir. 2000).

In the present case, the problem to be solved is to produce a detergent composition which is in a paste or solid form over a wide temperature range, foams adequately, gives good sensation during use without causing a tingling sensation of the skin, exhibits superior stability, doesn't cause sliminess during rinsing, and exhibits a creamy foam quality (Specification, page 5, lines 1-8, and page 6, lines 1-9).

The '743 reference fails to disclose that the use of taurines and non-anionic surfactants having an HLB of 10 or more in any detergent composition, would solve the problems and/or

provide the advantages provided by the present invention. For this reason, it is clear that the prior art relied upon by the Examiner in the final rejection fails to suggest the desirability of the claimed invention. Consequently, the rejection fails as a matter of law in view of the above authority, and the Board would be justified in overruling the final rejection. Withdrawal of the rejection is accordingly respectfully requested.

Moreover, the '197 and '743 references fail to teach the unexpected results obtained by providing a paste or solid cleaning agent comprised of ingredients (a)-(e), as called for herein in base claim 8. In particular, the present inventors prepared numerous test compositions, and conducted numerous tests to determine the Kraft point of the test compositions, the external stability of the test composition after one week at 45°, the tingling sensation experienced by a user during use of the test compositions, foaming characteristics of the test compositions, smoothness at time of rinsing of the composition, moist sensation of the skin after drying, smoothness of the skin after drying, pH of the test composition, foam quality of the composition, refreshing sensation at the time of rinsing, and temperature dependence of the hardness.

Regarding the composition of base claim 8, tests were conducted to determine the stability, foaming and usability of same, the results of the test being shown in Table 1b on page 44, and as shown in Table 2b on page 45. As discussed on page 44, lines 2-14, it was unexpectedly discovered that, by combining two anionic surfactants (sodium lauroyl methyltaurate and sodium myristoyl methyltaurate) as ingredient (a) with sodium chloride as ingredient (b), glycerin as ingredient (c), and water as ingredient (d), a composition is produced which exhibited superior stability, good foaming and a refreshing sensation during use.

In contrast, Comparative Examples 1-4, failed to simultaneously exhibit good stability,

good foaming and a refreshing sensation during use. Comparative Example 4, which contained solely an anionic surfactant (sodium myristoyl glutamate), had good stability and a refreshing sensation, but exhibited poor foaming ability.

Importantly, as illustrated in Tables 3b and 4b on pages 52 and 53 of the instant application, it was unexpectedly discovered that, in contrast to Comparative Examples 1-V which only contained claimed ingredients (a)-(d), compositions additionally containing taurine as ingredient (e), in combination with claimed elements (a)-(d) (see Examples I-III therein) exhibited superior stability, foaming, and usability (refreshing sensation), AS WELL AS little tingling sensation during use, high foaming quality (creaminess), and excellent external appearance stability after 1 week at 45°.

Proof of an unexpected improvement can rebut a *prima facie* case of obviousness. *In re Murch* 464 F2d 1051, 175 USPQ 89 (CCPA 1972); *In re Costello* 480 F2d 894, 178 USPQ 290 (CCPA 1973). As discussed above, the present inventors unexpectedly discovered that superior stability, reduced tingling sensation experienced by a user during use, superior foaming, superior smoothness at time of rinsing, superior moist sensation of the skin after drying, superior smoothness of the skin after drying, superior foam quality of the composition, an improved refreshing sensation at the time of rinsing, and superior temperature dependence of the hardness of the composition of the present invention can be obtained when combining claimed elements (a)-(e) of base claims 1 and 8 in the manner called for in the claims herein. It is therefore believed that these test results evidencing unexpected results rebuts any *prima facie* case of obviousness.

In view of the deficiencies of the '197 reference and the '743 reference, and the unexpected improved properties of the composition claimed herein, it is believed that the Board would be justified in overruling the final rejection.

II. Whether the Examiner can retroactively apply a rejection, via a statement in an Advisory Action, that was NOT specifically and clearly predicated in the final Office Action.

The final Office Action which issued on June 28, 2006, included a section entitled "Response to Arguments", wherein the Examiner presented a rejection of all remaining claims, stating "Claims 1-6, 8, 10-11, 13-14 and 19-28 are rejected under 35 U.S.C. 103(a) as being obvious over JP (58-101197) in view of JP (2001233743)". Before this rejection, in the "Response to Arguments" section, the Examiner presented comments concerning JP (1-178596) and JP 2001-1233743. However, the Examiner never set forth a rejection of any of the claims based on the combination of JP (1-178596) and JP 2001-1233743.

As the Examiner had not predicated a rejection of any of the claims based on the '596 and '743 references, the undersigned's did not believe that the Examiner intended the comments to constitute a rejection of any of the claims based thereon. To clarify same, counsel for appellant, in the Response to Final Rejection mailed herein on August 24, 2006, stated that "[i]n the Response to Argument bridging pages 2 and 3 of the final Office Action the Examiner has also made a number of comments concerning the prior art. It is believed that these arguments do not constitute a rejection since they do not comply with 35 U.S.C. 132(a)". Thus, it was clearly

pointed out to the Examiner in the Response that it was understood by appellants that no rejection of the claims based on a combination of the '596 and '743 references had been predicated.

In response to the Response to Final Rejection mailed herein on August 24, 2006, the Examiner issued an Advisory Action, mailed September 12, 2006. On page 2 (Continuation Sheet), lines 3-5, of the Advisory Action, the Examiner stated that "[t]he examiner would like to clarify the record, wherein the final office action the examiner inadvertently omitted that claims 1-6, 8, 10-11, 13-14, and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP (1-178596) in view of JP (20011233743). Thus, in effect, the Examiner has retroactively applied a rejection to the final Office Action, via a statement in the Advisory Action.

The issue herein is whether an Examiner can retroactively apply a rejection, via a statement in an Advisory Action, which was NOT specifically and clearly predicated in a final Office Action. It is respectfully urged that the answer to this issue is in the negative, based on the Rules cited below (the pertinent parts thereof being placed in italics for the convenience of the Board):

37 CFR 1.104 (c) :

(c) Rejection of claims.

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable *will be rejected*.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part

relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

37 CFR 1.112 Reconsideration before final action.

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an inter partes reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. *The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104).* Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 41.31 of this title) has been taken (§ 1.116), or in an inter partes reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

37 CFR 1.112 provides for the reconsideration and continued examination of an application after reply by the applicant, and for the reconsideration and continued examination of a reexamination proceeding after a response by the patent owner. *If claims are rejected, or objections or requirements are made, the applicant or patent owner will be notified in the same manner as notification was provided after the first examination.* Applicant or patent owner may reply to such Office action (with or without amendment) in the same manner provided in 37 CFR 1.111, or 37 CFR 1.945 for an inter partes reexamination, unless such Office action indicates that it is made final (37 CFR 1.113), or an appeal under 37 CFR 41.31 has been taken (37 CFR 1.116), or such Office action indicates in an inter partes reexamination that it is an action closing prosecution (37 CFR 1.949) or a right of appeal notice (37 CFR 1.953). Once an appeal has been taken in an application or in an ex parte reexamination proceeding, any amendment (filed prior to an appeal brief) is subject to the provisions of 37 CFR 1.116(b) and (c), even if the appeal is in reply to a non-final Office action. See 37 CFR 41.33(b) for amendments filed with or after the filing of an appeal brief.

37 CFR 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.<

(b) *In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.*

706.07 Final Rejection [R-3]

STATEMENT OF GROUNDS

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply. If appeal is taken in such a case, the examiner's answer should contain a complete statement of the examiner's position. The final rejection letter should conclude with Form Paragraph 7.39.

MPEP 707.07(d) Language To Be Used in Rejecting Claims

Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used. The examiner should designate the statutory basis for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection. If the claim is rejected as broader than the enabling disclosure, the reason for so holding should be given; if rejected as indefinite the examiner should point out wherein the indefiniteness resides; or if rejected as incomplete, the element or elements lacking should be specified, or the applicant be otherwise advised as to what the claim requires to render it complete.

It is respectfully submitted that 37 C.F. R. 1.104(c), 37 C.F.R. 1.112, 37 C.F.R. 1.113, MPEP 706.07 and MPEP 707.07(d) all require the Examiner to clearly state any rejections of the claims made, so as to provide the applicant with a clear understanding of the condition of the application, enable the applicant to properly reply to same, and, if desired, enable the applicant to properly respond on appeal. In particular, as called for by MPEP 707(d), "[w]here a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used".

It is respectfully submitted that the final rejection herein failed to comply with the requirements of 37 C.F. R. 1.104(c), 37 C.F.R. 1.112, 37 C.F.R. 1.113, and MPEP 706.07, to the prejudice of the applicants. Further, it is respectfully submitted that the Examiner, when issuing the final Office Action on June 28, 2006, did not comply with the requirements of MPEP 707(d), that is, the Examiner failed to use the word "reject" when commenting on the application of the

teachings of the '596 and '743 to the present invention. Additionally, the Examiner did not identify which claims were being rejected.

To permit a retroactive application of a rejection, as in the present case, deprived applicants of the opportunity to fully consider and respond to the retroactive rejection. It is therefore respectfully requested that the Board rule that such a retroactive application of a final rejection is improper, and contrary to the above-identified authorities.

III. Rejection Under 35 U.S.C. 103(a) over JP 1-178596 in view of JP 2001-1233743.

In the event that the Board rules as to the above issue in the positive, i.e., allows retroactive application of a rejection into final Office Actions via an Advisory Action, appellants respond to the rejection of claims 1-6, 8, 10-11, 13-14 and 19-28 under 35 U.S.C. 103(a) over JP 1-178596 in view of JP 2001-1233743, as predicated in the Advisory Action mailed on September 12, 2006, as follows:

(a) Claims 1-6 and 20-24:

The JP 01-178596 reference (referred to as the '596 reference), owned by Shiseido Co., Ltd. the current assignee herein, discloses a detergent composition comprised of:

- (A) an alkyloylalkyltaurine salt anionic surfactant;
- (B) an alkyl glucoside;

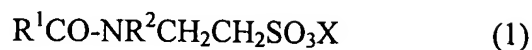
- (C) an amphoteric surfactant;
- (D) a higher alcohol;
- (E) an oil component;
- (F) a water soluble polymer; and
- (G) a cationic polymer.

In particular, Example 5 thereof, which pertains to a paste detergent composition, is manufactured with the following constituents:

5 mass% myristoylmethyl taurine-K
5 mass% alkyl glucoside (n=8, a=10)
10 mass% potassium myristate
10 mass% potassium stearate
1 mass% bees wax
5 mass% glycerol
5 mass% polyethylene glycol
Appropriate amounts of perfume
Residual ion exchange water

In the above paste detergent composition of the '596 reference, the *potassium myristate* and *potassium stearate (metal soaps)* serve as the main surfactants and together constitute 20 mass% of the composition. In contrast, the present invention, as claimed in base independent claim 1 herein, requires as the main surfactant, 5-50 mass % of an acyl salt anionic surfactant

represented by the following general formula (1):



(In this formula, R^1 denotes a hydrocarbon group having 10-24 carbons, R^2 denotes a hydrogen atom or methyl group, and X denotes an alkali metal, alkali earth metal, ammonium, or organic amine). Such an acyl salt anionic surfactant is disclosed only as a secondary, non-essential surfactant in the '596 reference, and is always present in a larger amount than secondary surfactants, such as the metal soaps disclosed in the '596 reference.

Further, the '596 reference fails to disclose the inclusion one or more of taurine, N-methyltaurine, and N,N-dimethyltaurine, in combination with elements (a)-(d), as required by base claim 1.

The '596 reference discloses a detergent composition comprised of:

- (a) an alkyloylalkyltaurine salt anionic surfactant;
- (b) an alkyl glucoside;
- (c) an amphoteric surfactant;
- (d) a higher alcohol;
- (e) an oil component;
- (f) a water soluble polymer; and
- (g) a cationic polymer.

The JP '743 reference, the Examiner's secondary reference, fails to cure the deficiencies of the '596 reference. In particular, the JP '743 reference discloses a hair detergent comprising 1 - 30 wt% of an *acyl N-methyltaurine salt* and 70 - 99 wt% of polyhydric alcohols. It is

respectfully submitted that, as discussed above, there is no disclosure whatever in the JP '743 reference of the use of one or more of taurines, N-methyltaurine and N, N-dimethyltaurine in combination with the ingredients (a) – (d), as called for in base claim 1 herein. On the contrary, that teaching or suggestion comes only from the present application, and constitutes an important element or aspect of the present invention.

(b) Claims 8, 10-11, 13, 14, 19 and 25-28:

The JP 01-178596 reference (hereinafter '596 reference) discloses a detergent composition comprised of:

- (H) an alkyloylalkyltaurine salt anionic surfactant;
- (I) an alkyl glucoside;
- (J) an amphoteric surfactant;
- (K) a higher alcohol;
- (L) an oil component;
- (M) a water soluble polymer; and
- (N) a cationic polymer.

In particular, Example 5 thereof, which pertains to a paste detergent composition is manufactured with the following constituents:

5 mass% myristoylmethyl taurine-K

5 mass% alkyl glucoside (n=8, a=10)

10 mass% potassium myristate
10 mass% potassium stearate
1 mass% bees wax
5 mass% glycerol
5 mass% polyethylene glycol
Appropriate amounts of perfume
Residual ion exchange water

In the above paste detergent composition, the potassium myristate and potassium stearate (metal soaps) serve as the main surfactants and together constitute 20 mass% of the composition. In contrast, the present invention, defined in base claim 8, requires as the main surfactant, one or more long chain acyl taurine salts, having a Kraft point of 40° or lower, represented by general formula (I) ($R_1 \text{ CO-NR}_2 \text{ -CH}_2 \text{ CH}_2 \text{ SO}_3 \text{ M}$, wherein R_1 denotes a saturated or unsaturated hydrocarbon group with an average number of carbon atoms of 7-19; R_2 denotes an alkyl group with an average number of carbon atoms of 1-3; and M denotes an alkali metal, alkali earth metal, ammonium, or organic amine or derivative).

Further, the '596 reference fails to disclose the inclusion of taurines and nonionic surfactants having a HLB of 10 or more, in combination with elements (a)-(d), as called for in amended base claim 8.

It is respectfully submitted that the secondarily cited JP '743 reference fails to cure the deficiencies of the '596 reference. In particular, the JP '743 reference discloses a hair detergent comprising 1 - 30 wt% of an acyl N-methyltaurine salt and 70 – 99 wt% of polyhydric alcohols.

It is respectfully submitted that there is no disclosure whatever in the JP '743 reference of the use of one or more taurines and nonanionic surfactants having a HLB of 10 or more together with the components (a) – (d), as called for base claim 8. On the contrary, that teaching or suggestion comes only from the present application, and constitutes an important element or aspect of the present invention.

In view of these deficiencies of the cited '596 and '743 references, it is respectfully submitted that the Examiner's proposed combination of references in no way anticipates or renders unpatentably obvious the subject matter called for in the claims 8, 10-11, 13, 14, 19 and 25-28 herein.

9. SUMMARY

The first of the three issues presented is whether all of the appealed claims (Claims 1-8, 8, 10, 11, 13, 14 and 19-28) are unpatentable under 35 U.S.C. 103(as) over the JP 58-101197 ('197) reference in view of the JP2001-233743 ('743) reference. It is undisputed that the primary '197 reference fails to disclose element (e) of either of base claims 1 or 8. In the final rejection, the Examiner maintains that the '743 reference discloses this important element (e).

With regards to base claim 1, it is submitted that the Examiner has erred in his technical interpretation of the '743 reference. In particular, the Examiner has relied upon the disclosure of "acyl N-methyltaurine", in the '743 reference, as constituting a prior disclosure of the claimed element (e) (i.e., N-methyltaurine). Appellant's urge that "N-acylmethyltaurine" and "N-methyltaurine" are structurally and compositionally different, and thus provide different effects in the composition. Since there is no basis in the record for equating "acyl N-methyltaurine" of the '743 reference with the "N-methyltaurine" called for in the appealed claims herein, there is no justification for the Examiner's conclusion that it would have been obvious to include N-methyltaurine in the composition of claim 1, based upon the teaching of the '743 reference.

The same reasoning applies to the final rejection of base claim 8, in which the Examiner has erred in his technical interpretation of the '743 reference, in that the Examiner equates the disclosure of "acyl N-methyltaurine", in the '743 reference, as constituting a prior disclosure of claimed element (e) (i.e., taurines and nonionic surfactants having a HLB of 10 or more). Clearly, "N-acylmethyltaurine" and "N-methyltaurine" are structurally and compositionally different, and thus provide different effects in the composition. Moreover, the '743 reference

fails to teach or suggest the limitation of the HLB parameter which was discovered to provide unexpected results herein.

The second issue is whether the Examiner can retroactively apply a rejection, via a statement in an Advisory Action, which was NOT specifically and clearly predicated and set forth in the final Office Action. It is believed that the language of 37 C.F. R. 1.104(c), 37 C.F.R. 1.112, 37 C.F.R. 1.113, MPEP 706.07 and MPEP 707.07(d) requires the Examiner to clearly state that claims are rejected and identify the claims rejected. In particular, MPEP 707.07(d) clearly requires that the word “reject” be used when making a rejection of a claim. The final rejection clearly failed to comply with the requirements of the above authorities.

If the Board refuses to disallow the retroactive application of the rejection predicated in the Advisory Action, it is respectfully requested that the Board consider the issue of whether the appealed claims are unpatentable under 35 U.S.C. 103(a) over JP 1-178596 (‘596) in view of JP 2001-1233743 (‘743).

In the final Office Action, the Examiner concedes that the ‘596 reference fails to teach the claimed N-methyltaurine, i.e., element (e) of base claim 1. The ‘743 reference fails to cure this deficiency, since the ‘743 reference discloses only the structurally and compositionally different “acyl N-methylaurine salt” compound. In view of the unexpected results obtained by using N-methyltaurine, and the lack of any basis in the record for equating “acyl N-methyltaurine” with “N-methyl taurine”, there is no logical justification for concluding that it would have been obvious to add N-methyltaurine to the composition taught by the ‘596 reference.

Regarding base claim 8, the ‘743 reference also fails to teach or suggest element (e), i.e. “one or more chosen from taurines and nonionic surfactants having a HLB of 10 or more”. It is

therefore believed that the Examiners' combination of references fails to render unpatentably obvious any of the subject matter in the appealed claims.

In view of the foregoing, it is respectfully submitted that the final rejections are improper and unwarranted, and the Board is accordingly respectfully requested to so rule.

Respectfully submitted,

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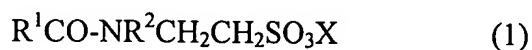
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APPENDIX I

The Claims on Appeal

1. A paste or solid cleaning agent composition comprising:

(a) 5-50 mass % of an acyl salt anionic surfactant represented by the following general formula (1):



(In this formula, R^1 denotes a hydrocarbon group having 10-24 carbons, R^2 denotes a hydrogen atom or methyl group, and X denotes an alkali metal, alkali earth metal, ammonium, or organic amine),

(b) one or more chosen from inorganic salts, organic acids, and organic salts,

(c) polyethylene glycol,

(d) water wherein the total electrolyte molar concentration is 1.8 mol/kg or more, and

(e) one or more chosen from taurine, N-methyltaurine, and N,N-dimethyltaurine.

2. The cleaning agent composition of claim 1, wherein R^1 of the (a) ingredient comprises a lauric acid residue and/or myristic acid residue.

3. The cleaning agent composition of claim 1, wherein the organic acid and organic salt of the (b) ingredient is one or more chosen from citric acid, succinic acid, lactic acid, malic acid, glycolic acid, tartaric acid, and acidic amino acids, as well as their salts.

4. The cleaning agent composition of claim 1, wherein the molecular weight of the (c) ingredient is 200-1,000.

5. The cleaning agent composition of claim 1, further comprising (f) a nonionic surfactant.

6. The cleaning agent composition of claim 5 wherein (e) is polyoxyethylene glycerin monoisostearate having a HLB of 10-15.

8. A paste or solid cleaning agent composition having a system melting point of 40° or higher, comprising:

(a) one or more long chain acyl taurine salts, having a Kraft point of 40° or lower, represented by the following general formula (I):



(In this formula, R₁ denotes a saturated or unsaturated hydrocarbon group with an average number of carbon atoms of 7-19; R₂ denotes an alkyl group with an average number of carbon atoms of 1-3; and M denotes an alkali metal, alkali earth metal, ammonium, or organic amine or derivative),

(b) one or more chosen from inorganic salts and organic salts,

(c) trihydric or higher polyol,

(d) water, and

(e) one or more chosen from taurines and nonionic surfactants having a HLB of 10 or more.

10. The cleaning agent composition of claim 8 wherein at least one of the constituents of the (b) ingredient is the same type of metal ion salt as the counter ion of the (a) ingredient.

11. The cleaning agent composition of claim 10 wherein, in the (b) ingredient, the molar ratio of the same type of metal ion salt as the counter ion of the (a) ingredient is one or more to the metal ion salt of types other than the counter ion of the (a) ingredient.

13. The cleaning agent composition of claim 8, wherein the nonionic surfactant having a HLB of 10 or more, used for the (e) ingredient, is one or more chosen from POE (=polyoxyethylene) glycerin monoisostearate, POE dialkyl ether, and POE hydrogenated castor oil, as well as derivatives thereof.

14. The cleaning agent composition of claim 8, wherein the melting point of the system is 45° or higher.

19. The cleaning agent composition of claim 13 wherein the melting point of the system is 45° or higher.

20. The cleaning agent composition of claim 1, wherein (b), in the presence of (a), (c), (d) and (e), has a melting point of 45° or higher.

21. The cleaning agent composition of claim 1, wherein the composition comprises 1-10 mass% of ingredient (b).

22. The cleaning agent composition of claim 1, wherein the composition comprises 2-40 mass% of ingredient (c).

23. The cleaning agent composition of claim 1, wherein the composition comprises 5-60 mass% of ingredient (d).

24. The cleaning agent composition of claim 5, wherein the composition comprises 0.01-5 mass% of ingredient (f).

25. The paste or solid cleaning agent composition of claim 8, wherein the composition comprises 5 mass% or more of ingredient (a).

26. The paste or solid cleaning agent composition of claim 8, wherein the composition comprises 1-10 mass% of ingredient (b).

27. The paste of solid cleaning agent composition of claim 8, wherein the composition comprises 2-40 mass% of ingredient (c).

28. The paste or solid cleaning agent composition of claim 8, wherein the composition comprises 5-60 mass% of ingredient (d).

APPENDIX II

Evidence

None.

APPENDIX III

Related Proceedings

None.



DOCKET NO. TOS-164-USA-PCT

CERTIFICATE OF MAILING

I hereby certify that this 41-page Appellant's Brief on Appeal, in Docket No. TOS-164-USA-PCT, Serial No. 10/517,147, filed December 7, 2004, is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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Donald E. Townsend